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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,594	10/01/2001	John S. Hendricks	007412.00393	5653
71867                      7590                      07/10/2009 BANNER & WITCOFF, LTD ATTORNEYS FOR CLIENT NUMBER 007412 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER				
SHELEHEDA, JAMES R				
ART UNIT		PAPER NUMBER		
2424				
MAIL DATE		DELIVERY MODE		
07/10/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/966,594

**Applicant(s)**

HENDRICKS, JOHN S.

**Examiner**

JAMES SHELEHEDA

**Art Unit**

2424

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7,10,15-17 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,10,15-17 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/27/09 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 05/27/09 have been fully considered but they are not persuasive.

On pages 8-9, applicant argues that Strubbe '924 fails to teach "passively" identifying frequently watched programming because Strubbe '924 discloses that the system performs the monitoring "at the option of the user".

In response, Strubbe '924 specifically disclose two types of tracking, one requiring active participation of the viewer in performing the ratings (column 4, lines 59-68) and one that is performed automatically without requiring user input for each recorded program record (column 5, lines 23-32). This clearly qualifies as "passively identifying" the programming, as the actual monitoring and identifying steps are performed in a purely passive manner. User input is no longer required for the tracking

and identifying to take place (column 5, lines 23-32). Any user action to activate the functionality, such as pushing an "on" key or some other action, does not negate the fact that the system being activated is a passive *monitoring* system that performs the *monitoring/tracking* without requiring user action. Therefore, applicant's arguments are not convincing, as Strubbe '924 clearly discloses a system which performs "identifying" in a passive manner.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-7, 10, 15-17 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strubbe (5,223,924) (of record) (incorporating by reference Strubbe et al. (5,047,867) (Strubbe '867) [see Strubbe '924 at column 2, lines 31-49 and column 4, lines 27-38] in view of Goldstein (5,410,326) (of record).

As to claim 1, while Strubbe '924 discloses a set top terminal for generating an interactive electronic program guide for display on a television connected to the set top terminal (see Strubbe '924 at Fig. 1; column 1, line 56-column 2, line 15), the terminal comprising:

means for retrieving information (see Strubbe '924 at column 4, line 59-column 5, line 32) via a program control information signal (TV program information data signal;

see Strubbe '924 at column 3, line 59-column 4, line 2) of a program selected from a plurality of programs and watched by a subscriber (see Strubbe '924 at column 5, lines 26-32);

means for storing said information (memory section, 52, Fig. 3; see Strubbe '924 at column 4, lines 17-26);

means for passively identifying (CPU, 50) frequently watched programs most often watched by said subscriber based upon said stored information (automatically identifying watched programs based upon the first database; see Strubbe '924 at column 4, lines 21-26 and column 5, lines 23-32);

means for receiving a television signal (see Strubbe '924 at column 3, lines 38-58);

means for extracting individual programs from the television signal (see Strubbe '924 at column 3, lines 38-58);

means for generating an electronic program guide for controlling display of content on a television screen (see Strubbe '924 at column 3, line 59-column 4, line 27 and column 5, lines 33-47), the guide comprising:

a favorites menu including names of programs available for selection (see Strubbe '924 at column 5, lines 12-47), wherein the programs included in the favorites menu are based on the identified frequently watched programs (customized program listing based upon the identified watched programs; column 5, lines 24-42);

means for receiving selection signals from a user input (see Strubbe '924 at column 4, line 59-column 5, line 47) of a program that will be broadcast at a future time

selected from said favorites menu (see Strubbe '867 at Fig. 8a and column 6, lines 25-49);

means for notifying said subscriber that a change of channel is imminent based upon nearing said future time of said program that will be broadcast at said future time (column 6, lines 42-49); and

means for changing said channel to said program at said future time (column 6, lines 42-49), he fails to specifically disclose tracking a number of times said subscriber watches a program.

In an analogous art, Goldstein discloses a television system (Fig. 1) which will monitor user actions and passively track the number of times a subscriber watches a channel (Fig. 20; column 26, lines 27-48) for identifying the channels most often watched by the viewer and determine favorites (Fig. 20; column 26, lines 15-62) for the typical benefit of more accurately identifying which viewed channels are preferred, by sorting the viewed channels by the frequency of viewing (column 26, lines 27-48).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Strubbe '924 to include tracking a number of times said subscriber watches a program, as taught by combination with Goldstein, for the typical benefit of more accurately identifying which viewed channels are preferred, by sorting the viewed channels by the frequency of viewing.

As to claim 3, Strubbe '924 and Goldstein disclose means for storing in memory identifiers of the frequently watched programs (see Strubbe '867 at column 5, lines 20-32 and column 4, lines 23-29 and see Strubbe '924 at column 5, lines 23-32).

As to claim 4, Strubbe '924 and Goldstein disclose wherein the means for retrieving said information includes means for identifying frequently watched channels (see Strubbe '867 at Fig. 6a; column 5, lines 20-32, column 4, lines 23-29 and column 1, lines 50-62) and means for storing in memory the frequently watched channels (see Strubbe '867 at column 5, lines 20-32, column 4, lines 23-29 and column 1, lines 50-62).

As to claim 5, Strubbe '924 and Goldstein disclose wherein the menu includes a list of frequently watched programs (see Strubbe '867 at Fig. 6a; column 5, lines 20-32, column 4, lines 23-29 and column 1, lines 50-62 and Strubbe '924 at column 5, lines 33-42).

As to claim 6, Strubbe '924 and Goldstein disclose wherein the means for generating includes means for generating the favorites menu to display programs selected by the means for identifying (see Strubbe '924 at column 5, lines 33-47 and column 6, lines 5-19).

As to claims 7, 21 and 23, while Strubbe '924 discloses a set top terminal (see Strubbe '924 at Fig. 1; column 1, line 56-column 2, line 15), and corresponding apparatus and method, comprising:

a processor (Fig. 1, 35), and

memory storing instructions that, when executed by the processor, cause the apparatus to perform (column 4, lines 3-26):

means for receiving information including information (see Strubbe '924 at column 4, line 59-column 5, line 32) via a program control information signal (TV program information data signal; see Strubbe '924 at column 3, line 59-column 4, line 2) about television viewing preferences of a subscriber (see Strubbe '924 at column 5, lines 26-32);

a memory that stores the information (see Strubbe '924 at Fig. 3, 54, column 4, line 59-column 5, line 32);

means for identifying (CPU, 50) frequently watched programs most often watched by said subscriber based upon said stored information (automatically identifying watched programs based upon the first database; see Strubbe '924 at column 4, lines 21-26 and column 5, lines 23-32);

means for receiving a television signal from an operations center (see Strubbe '924 at column 3, lines 38-58);

means for extracting from the signal individual programs for display on a television associated with the terminal (see Strubbe '924 at Fig. 1; column 3, lines 38-58); and



means for generating an interactive program menu on the television (see Strubbe '924 at column 3, line 59-column 4, line 27 and column 5, lines 33-47), listing a group of available programs (see Strubbe '924 at column 5, lines 12-47), the group being based on said identified frequently watched programs (see Strubbe '924 at column 5, lines 12-47);

means for receiving a signal from a user input device (see Strubbe '924 at column 4, line 59-column 5, line 47) selecting a program available at a future time selected from said group of identified frequently watched programs (see Strubbe '867 at Fig. 8a and column 6, lines 25-49);

means for notifying said subscriber that a change of channel is imminent based upon nearing said future time of said program that will be broadcast at said future time (column 6, lines 42-49); and

means for changing said channel to said program at said future time (column 6, lines 42-49), he fails to specifically disclose tracking a number of times said subscriber watches a program.

In an analogous art, Goldstein discloses a television system (Fig. 1) which will monitor user actions and track the number of times a subscriber watches a channel (Fig. 20; column 26, lines 27-48) for identifying the channels most often watched by the viewer and determine favorites (Fig. 20; column 26, lines 15-62) for the typical benefit of more accurately identifying which viewed channels are preferred, by sorting the viewed channels by the frequency of viewing (column 26, lines 27-48).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Strubbe '924 to include tracking a number of times said subscriber watches a program, as taught by combination with Goldstein, for the typical benefit of more accurately identifying which viewed channels are preferred, by sorting the viewed channels by the frequency of viewing.

As to claim 10, Strubbe '924 and Goldstein disclose wherein the television viewing preferences include frequently watched channels (see Strubbe '867 at Fig. 6a; column 5, lines 20-32, column 4, lines 23-29 and column 1, lines 50-62).

As to claim 15, Strubbe '924 and Goldstein disclose means for receiving program content information for the individual programs from the operations center (see Strubbe '924 at column 3, line 59-column 4, line 16); and

wherein the means for generating comprises means for generating the menu including said identified frequently watched programs (see Strubbe '924 at column 5, lines 33-47 and column 6, lines 5-19).

As to claim 16, while Strubbe '924 discloses a set top terminal for generating a customized menu of available programs for selection by a user (see Strubbe '924 at Fig. 1; column 1, line 56-column 2, line 15), the terminal comprising:

means for receiving a television signal (see Strubbe '924 at column 3, lines 38-58);

means for extracting individual programs from the television signal (see Strubbe '924 at Fig. 1; column 3, lines 38-58);

means for matching individual programs to said user based upon information received via a program control information signal (TV program information data signal; see Strubbe '924 at column 3, line 59-column 4, line 2) about television viewing preferences of said user used to identify frequently watched programs most often watched by said user (see Strubbe '924 at column 5, lines 26-32); and

means for generating an interactive program menu (see Strubbe '924 at column 3, line 59-column 4, line 27 and column 5, lines 33-47) that displays a group of programs based on said identified frequently watched programs (see Strubbe '924 at column 5, lines 12-47 and column 6, lines 5-24);

means for receiving a signal from a user input device (see Strubbe '924 at column 4, line 59-column 5, line 47) selecting a program available at a future time selected from said group of identified frequently watched programs (see Strubbe '867 at Fig. 8a and column 6, lines 25-49);

means for notifying said subscriber that a change of channel is imminent based upon nearing said future time of said program that will be broadcast at said future time (column 6, lines 42-49); and

means for changing said channel to said program at said future time (column 6, lines 42-49), he fails to specifically disclose tracking a number of times said subscriber watches a program.

In an analogous art, Goldstein discloses a television system (Fig. 1) which will monitor user actions and track the number of times a subscriber watches a channel (Fig. 20; column 26, lines 27-48) for identifying the channels most often watched by the viewer and determine favorites (Fig. 20; column 26, lines 15-62) for the typical benefit of more accurately identifying which viewed channels are preferred, by sorting the viewed channels by the frequency of viewing (column 26, lines 27-48).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Strubbe '924 to include tracking a number of times said subscriber watches a program, as taught by combination with Goldstein, for the typical benefit of more accurately identifying which viewed channels are preferred, by sorting the viewed channels by the frequency of viewing.

As to claim 17, Strubbe '924 and Goldstein disclose wherein the means for matching comprises means for matching based on information regarding content of the individual programs (see Strubbe '924 at column 5, line 48-column 6, line 4 and column 3, line 59-column 4, line 2) provided in said program control information signal (see Strubbe '924 at column 3, line 59-column 4, line 2).

As to claims 22 and 24, Strubbe '924 and Goldstein disclose decompressing the television signal to obtain the extracted individual programs from the television signal (column 2, lines 50-60 and column 3, lines 38-58); and

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wherein said generating of said electronic program guide includes at least one of the extracted individual programs (column 3, lines 27-37).

### ***Conclusion***

5. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sheleheda/

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Primary Examiner, Art Unit 2424

JS